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09/829,619	04/10/2001	Joseph Tesler	1481.007	7991

7590 12/21/2006  
Morris E. Cohen  
Suite 217  
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Brooklyn, NY 11230

EXAMINER
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COLILLA, DANIEL JAMES

ART UNIT	PAPER NUMBER
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2854

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	12/21/2006	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

09/829,619

Applicant(s)

TESLER, JOSEPH

Examiner

Daniel J. Colilla

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-35 and 37-40 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 August 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

*This action is essentially a repeat of the previous action with the addition of the rejection of newly added claims 34-40.*

#### ***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-6, 27, 31 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's disclosure of the prior art in view of Erickson.

With respect to claim 1, applicant's admission of prior art discloses the claimed method except for the automated placement of text with a single movement of the human hand. In applicant's disclosure of the prior art, as outlined in pgs. 4-6, applicant discloses that the requirements for preparing a Jewish religious scroll are known. These requirements include placing text of a Jewish religious scroll onto kosher parchment by hand so that the scroll does not have any defects in each letter and each letter is separated. It is also known, as disclosed by applicant, to prepare a Jewish religious scroll so that no letters touch one another (parent application 09/792,474, paragraph [0015], lines 10-12). Erickson teaches a method for automatically placing text 6 onto a substrate 7 with a squeegee 5 as shown in Figure 3 of Erickson. Additionally, Erickson teaches that the squeegee is used to draw the ink across the screen cloth 2 so that the ink will pass through the open areas of the text 6 leaving a print on the

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workpiece 7 (Erickson, col. 3, lines 44-30). It would have been obvious to combine the teaching of Erickson with applicant's admission of prior art for the advantage of automating the placement of text on a substrate and therefore reducing the time it takes to hand write a document. Furthermore, it would have been obvious to one of ordinary skill in the art to print the text with no defects according to the required level of quality.

With respect to claims 2-5, applicant's admission of prior art discloses that it is known to print a Torah scroll, a Megillah scroll, a Mezzuzah scroll and a Tefillin scroll. It would have been obvious to one of ordinary skill in the art to screen print and desired document in view of the teaching of Erickson.

With respect to claim 6, Erickson teaches a silk screen template 2.

With respect to claim 27, on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

With respect to claim 31, applicant's admission of prior art (parent application, 09/792,474, paragraph 19, lines 3-6) 2, discloses that it is known to recite a blessing and when printing the name of "G-d" on a scroll.

With respect to claim 34, it is well known to use religious scrolls for Jewish prayer services as indicated in applicant's admitted prior art (pages 1-2 of the specification, paragraphs 1-5 of the Background of the Art).

3. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6 above, and further in view of Akhdar *et al.*

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With respect to claim 7, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Akhdar *et al.* teaches that it is known in silk screening processes to use an ultraviolet ink (paragraph [0129]). It would have been obvious to combine the teaching of Akhdar *et al.* with the method disclosed by applicant's admission of prior art in view of Erickson for the quick curing advantages of ultraviolet of ink.

With respect to claim 8, Akhdar *et al.* further teaches that the ink is water-based (paragraph [0109], lines 1-4). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

4. Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Dunson.

With respect to claim 8-10, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except that it is not known if the ink is heat sensitive. However, Dunson teaches that it is known to use heat sensitive ink in silk screening. In col. 4, lines 17-24, Dunson discloses that the ink is cured by illumination devices 14. It would have been obvious to combine the teaching of Dunson with the method disclosed by applicant's admission of prior art in view of Erickson for the advantage of the safety device for reducing scorch of the substrate being printed (Dunson, col. 3, lines 47-49).

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5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Hackett.

Applicant's admission of prior art in view of Erickson, discloses the claimed method, except that it is not known if the content being reproduced is based on a pre-existing document. However, it is well-known in the silk screening art to reproduce an original image by use of a silk screen (Hackett, pg. 1, paragraph 0004). It would have been obvious to combine the teaching of Hackett with the method disclosed by applicant's admission of prior art in view of Erickson, for the advantage of creating copies of popular works. As mentioned above, there appears to be no unobviousness in the selection of the particular work that is being reproduced.

6. Claims 12, 29 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Libby.

With respect to claim 12, applicant's admission of prior art in view of Erickson, discloses the claimed method except for etching grid lines into the parchment. However, Libby teaches that it is known to emboss a grid pattern in a writing media (Libby, col. 2, lines 40-48). It would have been obvious to combine the teaching of Libby with the method disclosed by applicant's admission of prior art in view of Erickson, for the advantage of using the embossed lines for aiding in layout and alignment of text or images on the media.

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With respect to claim 29, applicant's admission of prior art in paragraph [0014] of parent application 09/792,474 discloses that it is known to print the top of each letter in a scroll so that it hangs from *sirtut*.

With respect to claim 32, applicant's admission of prior art (parent application, 09/792,474, paragraph 19, lines 3-6), discloses that it is known to recite a blessing and when printing the name of "G-d" on a scroll.

7. Claims 21-22, 26, 28, 30, 33, 35 and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's disclosure of the prior art in view of Erickson.

With respect to claim 21, applicant's admission of prior art discloses the claimed method except for the automated placement of text with a single movement of the human hand. In applicant's disclosure of the prior art, as outlined in pgs. 4-6, applicant discloses that the requirements for preparing a Jewish religious scroll are known. These requirements include placing text of a Jewish religious scroll onto kosher parchment by hand so that the scroll does not have any defects in each letter and such that no letters touch another letter on the document. Additionally, applicant discloses on pg. 4, lines 5-6 that it is known to place *sirtut* (horizontal guidelines) on a scroll when printing a Kosher religious text. Erickson teaches a method for automatically placing text 6 onto a substrate 7 with a squeegee 5 as shown in Figure 3 of Erickson. Additionally, Erickson teaches that the squeegee is used to draw the ink across the silk screen cloth 2 so that the ink will pass through the open areas of the text 6 leaving a print on the workpiece 7 (Erickson, col. 3, lines 44-30). It would have been obvious to combine the teaching of Erickson with applicant's admission of prior art for the advantage of automating the

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placement of text on a substrate and therefore reducing the time it takes to hand write a document. Furthermore, it would have been obvious to one of ordinary skill in the art to print the text with no defects according to the required level of quality.

With respect to claims 22 and 28, on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

With respect to claims 26, the first full paragraph on page 6 of applicant's specification discloses that reciting a blessing and imprinting the name "G-d" has long been a known tradition. *It appears that when using the term "G-d" applicant intends to mean that the actual term being printed in the religious scroll includes an "o" between the "G" and "d" rather than a "-". As the examiner understands it, the term with the "o" is not permitted except when using the name in a religious scroll or prayer and the term "G-d" is used at all other times.*

With respect to claim 30, applicant's admission of prior art in paragraph [0014] of parent application 09/792,474 discloses that it is known to print the top of each letter in a scroll so that it hangs from sirtut.

With respect to claim 33, applicant's admission of prior art in paragraph [0014] of parent application 09/792,474 discloses that it is known to print the top of each letter in a scroll so that it hangs from sirtut. Applicant's admission of prior art (parent application, 09/792,474, paragraph 19, lines 3-6), also discloses that it is known to recite a blessing and when printing the name of "G-d" on a scroll. Additionally, and on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.



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With respect to claim 35, it is well known to use religious scrolls for Jewish prayer services as indicated in applicant's admitted prior art (pages 1-2 of the specification, paragraphs 1-5 of the Background of the Art).

With respect to claims 37-40, applicant's admission of prior art discloses that it is known to print a Torah scroll, a Megillah scroll, a Mezzuzah scroll and a Tefillin scroll. It would have been obvious to one of ordinary skill in the art to screen print and desired document in view of the teaching of Erickson.

8. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over applicant's admission of prior art in view of Erickson, as applied to claims 1-6, 27 and 31 above, and further in view of Akhdar *et al.*

With respect to claim 23, applicant's admission of prior art in view of Erickson discloses the claimed method for preparing a Jewish religious scroll except for the step of providing an ultraviolet ink. However, Akhdar *et al.* teaches that it is known in silk screening processes to use an ultraviolet ink (paragraph [0129]). It would have been obvious to combine the teaching of Akhdar *et al.* with the method disclosed by applicant's admission of prior art in view of Erickson for the quick curing advantages of ultraviolet of ink.

With respect to claim 24, Akhdar *et al.* further teaches that the ink is water-based (paragraph [0109], lines 1-4). A water based ink is heat sensitive since as the water evaporates from the ink due to application of heat, the ink will dry.

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With respect to claim 25, Akhdar *et al.* teaches ink as mentioned above, and on page 5, lines 10-11, of applicant's disclosure, applicant discloses that crowns on the printed letters are known.

***Allowable Subject Matter***

9. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

10. The following is a statement of reasons for the indication of allowable subject matter:

Claim 36 has been indicated as containing allowable subject matter primarily for the a first screen of the text of the scroll without any of the names of G-d thereon, and a second screen with the names of G-d thereon, wherein said first screen is provided with spaces where the names of G-d are located on said second screen, and wherein said second screen is provided with spaces where said text of the scroll is located on said first screen.

*Note: It is presumed that when applicant uses the term "G-d," he actually intends the "--" symbol to represent --o--, but for religious reasons cannot type the letters "G," "o" and "d" to indicate the name he intends in the papers of this patent application. Thus the patent applicant is attempting to obtain protection for is for the name including the letters "G," "o" and "d", not the name "G-d" as recited in the claims.*

***Response to Arguments***

11. Applicant's arguments filed 10/12/2004 have been fully considered but they are not persuasive of any error in the above rejection. These arguments are repeated from the previous Office action.

With respect to applicant's arguments regarding the provisional applications of Hackett and Dunson, the provisional applications of each of these references support the disclosure relied upon in the above rejection. It is noted, however, that there is a typographical error in the Dunson patent which inaccurately lists the provisional document as SN 60/138,913. The provisional application is actually SN 60/136,913.

Additionally, the relied upon disclosure of the Akhdar *et al.* reference is supported by its provisional application.

Applicant may access the provisional applications for viewing and/or printing using the Public PAIR website <http://portal.uspto.gov/external/portal/pair>.

With respect to applicant's argument regarding the co-existence of silk-screening and preparation of Jewish religious scrolls. Although no art has been found in indicating that Jewish religious scrolls have been silk-screened, this does not render the combination novel. In fact the lack of a teaching in one reference is the very reason combination rejections exist. There are most likely thousands if not millions of particular textual documents that have not been silk-screened but would still have been obvious to silk-screen. The combination of the rejection indicates that Jewish religious scrolls are a known document and silk-screening is a known method of printing documents and therefore it would have been obvious to silk-screen Jewish religious scrolls. With respect to applicant's arguments regarding the precise placement of the

text, it is a common desire to print a document as perfectly as possible, free from any defects. In reality, there is a limit to the amount of precision that can be had due to economical factors. It would have been obvious to design a system with the amount of precision that is necessary to reach the desired level of perfection of the finished product.

With respect to applicant's argument that there is no evidence of record of silk-screening on animal parchment, it is noted by the examiner that animal parchment is a known printing media and silk-screen printing is a known method of printing. One of ordinary skill in the art would recognize this and would be able to use the general knowledge of the art in order to silk-screen on animal parchment.

Additionally, whether the parchment is Kosher or not, does not appear to have any physical effect on the capability of silk-screening on parchment.

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel J. Colilla whose telephone number is 571-272-2157. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

December 13, 2006



Daniel J. Colilla  
Primary Examiner  
Art Unit 2854